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Date: October 6, 2006

(Signature of person mailing paper or fax)

PATENT

Paper No.

File: NewMrkt-P99-4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors : Anthony F. Herbst and Wayne F. Perg
Serial No. : 09/467,646
Appeal No.: 2006-1174
Filed : December 20, 1999
For : DIGITAL COMPUTER SYSTEM FOR OPERATING A
CUSTOMIZABLE INVESTMENT FUND
Group Art Unit : 3628
Examiner : Bui, Thach H.

MS: Appeal Related Matters
Board of Patent Appeals and Interferences
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER

SIR :

Please enter the following enclosed documents in the above-identified patent application.

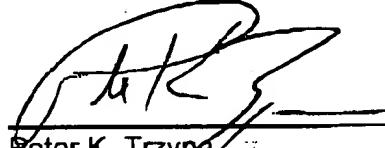
1. Request for Rehearing.

Applicant claims small entity status. The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235.

Ser. No. 09/467,646
Appeal No. 2006-1174
Art Unit: 3628
Atty Ref. Newmrkt-P4-99

Please direct all correspondence to the undersigned at the address given below.

Respectfully submitted,



Peter K. Trzyna
(Reg. No. 32,601)

Date: October 6, 2006

P.O. Box 7131
Chicago, IL 60680-7131
(312) 240-0824

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Alexandria, VA 22313-1450

REQUEST FOR REHEARING PURSUANT TO Sec. 37 CFR 41.52

SIR:

Applicant respectfully requests a rehearing on the record to address the new ground of rejection and, respectfully, errors pertaining to the newly cited art there applied. More particularly, the points believed to be misinterpreted or overlooked pertain to this new ground of rejection, and particularly claim-distinctions over the newly cited art.

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I. REMARKS

There is good cause for having not previously presented the argument set forth below, namely the citing of a new ground of rejection in the Decision of the Board. Further particularity regarding the errors is set forth below.

A. New Ground of Rejection

In the Decision of the Board of Patent Appeals and Interferences, in the above-referenced matter, the Board reversed the rejection of the patent application by the Examiner. However, the Decision has entered a new ground of rejection of claim 1. Claim 1 has been rejected pursuant to 35 U.S.C. Sec. 103. The Board contends that the claim is obvious over Wallman (U.S. Patent No. 6,338,047 B1).

The Board concedes that Wallman does not disclose the claimed outputting a separate accounting for each set of investments within the fund but contends that this requirement is essentially disclosed at Col. 9, lines 23-41 and "is known... to be required to meet regulatory agencies' audit requirements." (See Decision at page 9.)

B. Overview

The new ground is improper for want of a showing of *prima facie* obviousness.

By way of an overview, Wallman teaches a system of investments "that are selected based on the aggregated, individual preference of plural investors" (title) and as such has one set of investments that are "aggregated" (abstract). Wallman does not disclose more than one set of investments, which leads to acquisition of said investments, which in turn requires a separate accounting for each said set of investments, as is claimed by Applicant.

Further, nothing in Col. 9, lines 23-41, disclose Applicant's claimed accounting for each said set of investments (where the claim elsewhere requires more than one set) because Wallman has only one set of investments. Instead of Applicant's claimed approach, the

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accounting of Wallman reflects instead the "pro rata interest in the fund." See Col. 6., lines 29-30. See also Col. 9, lines 30-41.

The Board contends that "a separate accounting of each investment transaction, and therefore of the acquisition of each investment, is known...." This is not what is claimed. Indeed this manner of thinking and Wallman would have led one of ordinary skill in the art away from the claimed approach. More so, to modify Wallman to reach Applicant's claimed approach would contradict and change the operating principles of the aforementioned explicit statements of Wallman.

Further, the accounting to which the Board may be referring with regard to regulatory agencies appears to presume that these agencies have encountered Applicant's claimed method. Applicant requires a reference. Otherwise, Applicant presumes the Decision is referring to the kind of conventional accounting for funds set forth in Wallman.

C. Wallman discloses none of the claim 1 requirements

Wallman does not disclose a customizable investment fund as claimed.

For perspective, the specification indicates that a customizable investment fund pertains to "a computerized process that makes it possible for the fund to offer individual investors and/or their investment advisors the ability to purchase individually customized and (assuming that the investor so chooses) diversified sets of investments within a customizable investment fund (page 6, lines 5-8, U.S. Patent Application Serial No. 09/467,646).

This is in contrast to conventional investment funds, such as mutual funds, in which each investor holds an undivided interest in one portfolio of investments held by the fund. Therefore, every investor in the fund has exactly the same investments, but different shares in the fund. It is one size fits all – very different from a customizable investment fund in which one investor has a set of investments that may be different from another investor's set.

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Wallman teaches a method of managing a conventional mutual fund – a fund in which every investor holds exactly the same set of investments (an undivided interest in the portfolio of investments held by the mutual fund). Again, see the title and abstract of Wallman. Note the use of the singular with regards to the number of portfolios of investments – a mutual fund has only one portfolio of investments whereas a customizable investment fund has potentially as many portfolios as there are investors in the fund.

Given that Wallman explicitly describes a method of selecting the one set of investments for an ordinary mutual fund, it is not surprising that Wallman does not disclose claim 1.

Consider more particularly the final element of claim 1 of the present invention: outputting a separate accounting for each said set of investments within the fund.” Wallman does not disclose outputting a separate accounting for each said set of investments within the fund because, as pointed out above, a mutual fund has only one set of investments within the fund, namely the portfolio of investments held by the fund. There is no other set because every investor in the mutual fund holds exactly the same portfolio. Therefore, every investor receives the same accounting as regards the same set of investments, with the accounting for each investor differing only by the amount of their holding in their fund. Therefore, Wallman does not teach a separate accounting for each said set of investments within the fund.

Consider the following other requirements of claim 1:

receiving, at a central computer, first digital signals from a first computer specifying a custom set of investments for a fund;
receiving, at a central computer, second digital signals from a second computer specifying a custom set of investments for the fund;

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(emphasis added)

The Decision has interpreted the custom requirement out of the claim by according it no meaning. The Board can take official notice of the plain and ordinary meaning of the word by referring to a dictionary to interpret the word custom used as adjective. It is believed to that the first meaning given for the word custom used an adjective can be "made especially for individual customers; custom shoes."

While Wallman mentions receiving orders (column 9, lines 6-22) for the purchase of investments submitted by investors in the fund, these orders are not orders for custom sets of investments for the fund because they are not (as is the case in a customizable investment fund) "made especially for individual customers" of the fund. The sets of investments in Wallman cannot be "made especially for individual customers" of the fund because, as a mutual fund, the fund holds only one portfolio of investments and that same set of investments is held by all investors in the fund. It is not possible for a mutual fund to hold sets of investments "made especially for individual customers." Therefore, Wallman does not disclose:

receiving, at a central computer, first digital signals from a first computer
specifying a custom set of investments for a fund;
receiving, at a central computer, second digital signals from a second
computer specifying a custom set of investments for the fund....

Given that Wallman does not disclose either of the receiving steps, it is not possible for Wallman to disclose the acquisition of said investments, nor entering transaction data... reflecting acquisition of said investments, nor outputting a separate accounting for each set of investments within the fund.

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In sum, Wallman does not teach any element of claim 1, or the claim as a whole, all flowing from the fact that Wallman does not disclose a customizable investment fund. The application of Wallman as a new ground of rejection, for the reasons cited herein, it is respectfully submitted, constitutes an error in which the Board has misinterpreted or overlooked claim distinction over the cited art.

With respect to the other art cited in the Decision, none mentions more than one set of investments, which leads to acquisition of said investments, which in turn requires a separate accounting for each said set of investments, as is claimed by Applicant.

In conclusion, Applicant requests withdrawal of the new ground of rejection and allowance of the claims over the cited art.

II. Conclusion

The rejection of Appellant claims has not been shown to be *prima facie* obvious pursuant to the standards of 35 U.S.C. Sec. 103. No one would ever have thought of the claimed invention from the cited art, and indeed, one would have to discard the systems of the cited art, and indeed violate the teaching of Wallman, to reach claim 1. Accordingly, and based on the evidence of record considered in accordance with the foregoing statutory requirements, the new ground of rejection should be withdrawn and the claims should be allowed.

APPLICANT CLAIMS SMALL ENTITY STATUS. The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235.

Respectfully submitted,



Peter K. Trzyna
(Reg. No. 32,601)

Date: October 6, 2006

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No. of Pages: 10 (including cover)

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Message:

Dear Ms. Lee:

Enclosed please find a copy of the Request for Rehearing filed in the above-identified appeal on October 6, 2006. The Request was timely filed by fax to the number listed in the Decision, as evidenced by the enclosed fax receipt.

Please advise as to how best to proceed.

Very truly yours,

Peter K. Trzyna

TRANSMISSION VERIFICATION REPORT

TIME	:	10/06/2006 14:04
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FAX	:	
SER. #	:	BROEGF989146

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